



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,669	12/13/2000	Galen J. Suppes	UKCR.70086	8013

7590 06/05/2002

James H. Marsh, Jr.  
SHOOK, HARDY & BACON L.L.P.  
1200 Main Street  
Kansas City, MO 64105-2118

EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/05/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/736,669	<b>Applicant(s)</b> SUPPES ET AL. <span style="float: right;"><i>[Signature]</i></span>	
	<b>Examiner</b> Margaret B. Medley	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on \_\_\_\_.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-28 is/are rejected.

7) ☐ Claim(s) \_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other:
---	--

### DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4 and 8-10 are indefinite in that each claim appears to duplicate each other in that each are an additive of a nitrated C1-C4 ester of a fatty acid having the same inherent properties of lubricity enhancement, detergency enhancement and cetane enhancement. Claim 5 is indefinite for the term "improved" which does not describe the improvement, and because it appears that the cetane improver is the only component of the fuel. Clarification to claim 5 is required to clarify if the claim is directed to a diesel fuel composition. Claims 6 and 7 are indefinite in that it is unclear if the ester forming step has proper basis from claim 1 and it is unclear from the record that the additives of claims 2, 3 and 4 are the one and same additive of claim 1 or if each of the additives of claims 2, 3 and 4 are different than claim 1 additive.

Clarification is required. Claims 11-14 are indefinite in that each of the said claims appears to duplicate one another in that each method is a one step process for admixing the nitrated C1-C4 ester of a fatty acid of the same nature to a diesel fuel imparting various properties to the diesel fuel. Claims 15 and 16 are indefinite in that

Art Unit: 1714

the ester forming step appears to be improper in that the method of claims 11-14 are directed to adding an additive to a diesel fuel and is not directed to a method for producing the ester. Claims 15 and 16 appear to duplicate claims 6 and 7. Claims 17-19 are indefinite in that they appear to be a substantial duplication of claims 11 and 15-16 because the instant step of adding the nitrated ester to the said diesel fuel is substantial the same step for admixing the nitrated ester to a diesel fuel of claims 11 and 15-16. Claims 20-22 are indefinite in that they appear to be a substantial duplication of claims 12 and 15-16 because the instant step of adding the nitrated ester to the said diesel fuel is substantial the same step for admixing the nitrated ester to a diesel fuel of claims 12 and 15-16. Claims 23-25 are indefinite in that they appear to be a substantial duplication of claims 13 and 15-16 because the instant step of adding the nitrated ester to the said diesel fuel is substantial the same step for admixing the nitrated ester to a diesel fuel of claims 13 and 15-16. Claims 26-28 are indefinite in that they appear to be a substantial duplication of claims 14-16 because the instant step of adding the nitrated ester to the said diesel fuel is substantial the same step for admixing the nitrated ester to a diesel fuel of claims 14-16. Method claims 11-16, 17-19, 20-22, 23-25 and 26-28 all appear to be a duplication of one another. Applicants may overcome the rejections by cancellation of the sets of claims that are a duplication of one another.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1714

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Admitted Prior Art.

Applicants make admission of record at pages 1-2 of the instant application that Admitted Prior Art, Poirier (U.S. Patent 5,454,842) teaches various known process for producing nitrated fatty acid derivatives and diesel fuel compositions having improved cetane enhancement with the addition of the said nitrated esters. Poirier teaches a process for producing fatty alcohols from tall oil, tall oil fatty acid, tall oil fatty acids esters, vegetable oils and mixtures thereof by hydrogenation followed by nitration,

Art Unit: 1714

column 3, lines 34-46 and column 4, lines 5-19. Patentee further teaches a process for esterification of the fatty acids produced by hydrolysis, column 4, lines 19-35.

Patentee further teaches process for adding a fatty alcohol nitrated ester to a diesel fuel having cetane enhancement <column 8, Table 1, and diesel fuel composition comprising said additive claims 1-5. The Admitted Prior Art is silent to the detergency and lubricity properties enhancement of the fatty alcohol nitrated esters. It is the examiner's position that the detergency and lubricity properties of the Admitted Prior Art are imparted to the diesel fuel composition at the same time that the cetane property enhancement is imparted to the diesel fuel composition in the absence of evidence of record to the contrary. The instant claims of record are anticipated by or, in the alternative are obvious over the teachings of the Admitted Prior Art of Poirier.

The prior cited but not applied further teaches nitrated additives and diesel fuel compositions of the same nature as that of applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday- Friday from 7:30 AM to 6:00 PM.

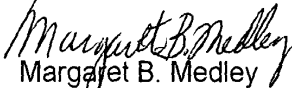
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Application/Control Number: 09/736,669

Page 6

Art Unit: 1714

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Margaret B. Medley  
Primary Examiner  
Art Unit 1714

Margaret B. Medley

June 02, 2002.